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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/125,700 Confirmation No.: 8084
Applicant(s): Fuhrmann et al.
Filed: 10/23/1998
Art Unit: 2642
Examiner: Hong, Harry S.
Title: Radiotelephone

Attorney Docket No.: 873.0185.U1(US); NC13479US
Customer No.: 29,683

Commissioner For Patents
P.O. Box 1450
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Appeal Brief

Sir:

This is an appeal brief in regard to the final rejection of claims in the above-identified patent application. A Notice of Appeal was mailed to the USPTO on 10/23/2006. The fee under 37 C.F.R. §41.20(b)(2) of \$330.00 was paid with the appeal brief filed 3/26/2004. Enclosed is a check for \$170.00 as payment to total the current fee of \$500.00. Please charge deposit account 50-1924 for any fee deficiency.

I. Real Party In Interest

The real party in interest is Nokia Corporation.

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II. Related Appeals and Interferences

This appeal relates to a prior appeal which was filed for this case (Application No. 09/125,700) which, in an Order mailed July 28, 2005, was returned to the examiner as requiring attention prior to docketing of the appeal. There are no other appeals of interferences.

III. Status Of Claims

Claims 1-9, 11-13 and 15-17 are pending in this application. Claims 1-9, 11-13 and 15-17 have been rejected by the Examiner. The rejection of Claims 1-9, 11-13 and 15-17 is appealed. Claims 10, 14 and 18-24 have been cancelled.

IV. Status Of Amendments

Since the final rejection of 07/25/2006 one amendment was filed on 10/23/2006 to simplify issues on appeal.

V. Summary of Claimed Subject Matter

Independent claim 1 claims an electronic radiotelephone comprising a first housing (18); a second housing (19); at least one key unit (24); and retaining means (19) (Fig. 5 and page 7, line 16 - page 8, line 12). The second housing (19) is user releasably attachable to the first housing (18) to meet with the first housing around the periphery of the radiotelephone. The second housing modifies the external appearance of the electronic radiotelephone to the personal

tastes of the user. The key unit (24) is for user-actuation of at least one key sensor (29). The retaining means comprising a cover (35) (page 9, lines 12 - page 10, line 5) for holding electronic components of the radiotelephone, including the key sensor (29) but excluding the key unit (24) to the first housing (18) when the second housing (19) is released from attachment with the first housing by the user. The "retaining means" can also comprise a circuit board (23) (see claim 3 and page 8, last paragraph). The key unit (24) is free to move with respect to the first housing (18) when the second housing (19) is released from attachment with the first housing by the user. The second housing (19) is releasably attachable, by the user, to the first housing (18) by a press-on/catch closure (11) so that the second housing (19) may be fitted on to the first housing (18) by pressing it on (page 10, lines 6-11, and page 5, lines 19-27).

Independent claim 15 claims an electronic radiotelephone comprising a back housing (18) providing at least one key sensor (29); at least one key unit (24) for user-actuation of the key sensor by a user; a front housing (19) for modifying the external appearance of the electronic radiotelephone to the personal tastes of the user (Fig. 5 and page 7, line 16 - page 8, line 12). The front housing has an opening (see Fig. 5) for receiving the key unit. The front housing (19) is user-releasable attachable to the back housing (18) to meet with the back housing around the periphery of the radiotelephone. The retaining means comprising a cover (35) (page 9, lines 12 - page 10, line 5) holding electronic components of the radiotelephone to the back housing (18) when the front housing is released from attachment with the back

housing by the user. The "retaining means" can also comprise a circuit board (23) (see claim 3 and page 8, last paragraph). When the front housing (19) is attached to the back housing (18), the key unit (24) is held between the front housing and the key sensor, and the key unit (24) is thereby received in the at least one opening of the front housing (19). The key unit (24) is removable by a user when the front housing is released from attachment with the back housing. The front housing is releasably attachable by the user to the back housing by a press-on/catch closure (11) so that said front housing may be fitted on to the back housing by pressing it on (page 10, lines 6-11, and page 5, lines 19-27).

Independent claim 16 claims an electronic radiotelephone comprising a first housing (18); a second housing (19) for modifying the external appearance of the electronic radiotelephone to the personal tastes of an user; a key unit (24); and retaining means. The second housing (19) is releasable attachable, by an user, to the first housing (18) to meet with the first housing around the periphery of the radiotelephone (see Fig. 5). The key unit is for user-actuation of at least one key sensor (29). (Fig. 5 and page 7, line 16 - page 8, line 12) The retaining means comprising a cover (35) (page 9, lines 12 - page 10, line 5) for holding electronic components of the radiotelephone to the first housing (18) when the second housing is attached to the first housing with the first housing. The "retaining means" can also comprise a circuit board (23) (see claim 3 and page 8, last paragraph). When the second housing is attached to the first housing, the key unit (24) is sandwiched between the second housing (19) and the key sensor (29), the key unit (24)

being free to move with respect to the first housing (18) when the second housing (19) is released from attachment with the first housing (18) by the user. The second housing is releasably attachable, by the user, to the first housing by a press-on/catch closure (11) so that said second housing may be fitted on to the first housing by pressing it on. (page 10, lines 6-11, and page 5, lines 19-27)

Independent claim 17 claims an electronic radiotelephone comprising a first housing (18) and a second housing (19) for modifying the external appearance of the electronic radiotelephone to the personal tastes of an user. (Fig. 5 and page 7, line 16 - page 8, line 12) The second housing (19) is releasable attachable, by an user, to the first housing (18) to meet with the first housing around the periphery of the radiotelephone. The electronic radiotelephone has attachment means for attaching the second housing to the first housing by a user without employing a tool. The attachment means can comprise latches (11) (page 10, lines 6-11, and page 5, lines 19-27). The second housing is releaseably attachable to the first housing by said attachment means which comprises a press-on/catch closure (11) so that said second housing may be fitted on-to the first housing by pressing it on (page 10, lines 6-11, and page 5, lines 19-27). The electronic radiotelephone also comprises at least one key unit (24) for user-actuation of at least one key sensor (29) and retaining means comprising a cover (35) (page 9, lines 12 - page 10, line 5), for holding electronic components of the radiotelephone to the first housing, including the key sensor (29) but excluding the key unit (24), when the second housing (19) is released from attachment with the first housing (18),

the key unit (24) being free to move with respect to the first and second housings when the second housing is released from attachment with the first housing by the user.

VI. Grounds of Rejection to be Reviewed on Appeal

- A. Are claims 1-9, 11-13 and 15-17 unpatentable under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement?
- B. Are claims 1-9, 11, 12 and 15-17 unpatentable under 35 U.S.C. §103(a) over Kobayashi et al. (US 5,722,055) in view of Semenik et al. (US 5,233,506)?
- C. Is claim 13 unpatentable under 35 U.S.C. §103(a) over Kobayashi et al. (US 5,722,055) in view of Semenik et al. (US 5,233,506) and Takagi (US 5,235,636)?

VII. Argument

A. 35 U.S.C. §112, first paragraph

The examiner has stated that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. More specifically, the examiner states that the specification contains two (2) embodiments; Figs. 1-4 and Fig. 5, respectively. The examiner indicates that the claims are directed to a combination of features from the first and second embodiments and, as such, this combination lacks

support in the specification. The examiner is correct that the claims are directed to a combination of features of the two specifically described embodiments. However, the examiner is incorrect that the specification is not enabling for this combination.

Claim 1

All of the elements of claim 1 are shown in Fig. 5 and/or described in the specification with respect to the second embodiment of Fig. 5 with the exception of the "press-on/catch closure". The press-on/catch closure is described in the specification and shown in the drawings with regard to the first embodiment shown in Figs. 1-4 and on page 5, last paragraph. The specification explains that "The present invention may include any novel features or combination of features disclosed herein..." (page 10, last paragraph). Thus, the specification describes that features of the different embodiments can be combined.

The examiner indicates that the disclosure at page 10, last paragraph is too generic and broad a statement to be given any patentable weight in regard to enablement. The examiner indicates that the statement in the specification that "The present invention may include any novel features or combination of features disclosed herein..." may refer to an infinite number of possible combinations of features, and does not provide enablement. The examiner stated that the mixing and matching of features from the two separate embodiments is not supported in the original specification. In view of the explicit mention in the specification of combinations, the examiner is clearly incorrect. The examiner cannot ignore the

disclosure in the specification (as he has been doing) that teaches "combination of features" (page 10). Furthermore, page 1, line 15 - page 4, second full paragraph do not make reference to either the first embodiment or the second embodiment and merely describe that the invention can preferably use attachment means with press-on/catch closure (see page 4, second full paragraph). A person skilled in the art, after reading the entire specification with reference to the drawings would clearly understand that a press-on/catch closure could be used in the embodiment shown in Fig. 5 and, more importantly, is enabling of the invention claimed in claim 1.

The specification clearly contains subject matter which is described in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention as claimed in claim 1. It should be remembered that a patent application is not intended to be a blueprint. A person skilled in the art would have to have a pretty low IQ not to realize that a radiotelephone having a press-on/catch closure along with the other features described with reference to Fig. 5 is not enabled from the teachings of the present patent application.

Claims 2-13 stand or fall with claim 1.

Claim 15

Claim 15 claims that the front housing is releasably attachable by the user to the back housing by a press-on/catch closure. All the features of claim 15 are shown in Fig. 5 with regard to the second embodiment with the exception of the

press-on/catch closure which is described in more detail with regard to the first embodiment shown in Figs. 1-4. However, as noted above, page 1, line 15 - page 4, second full paragraph do not make reference to either the first embodiment or the second embodiment and merely describe that the invention can preferably use attachment means with press-on/catch closure (see page 4, second full paragraph). In addition, the specification explains that "The present invention may include any novel features or combination of features disclosed herein..." (page 10, last paragraph). Thus, the specification describes that features of the different embodiments can be combined. There is enablement for the invention as claimed in claim 15.

Claim 16

Claim 16 claims that the second housing is releasably attachable, by the user, to the first housing by a press-on/catch closure. All the features of claim 16 are shown in Fig. 5 with regard to the second embodiment with the exception of the press-on/catch closure which is described in more detail with regard to the first embodiment shown in Figs. 1-4. However, as noted above, page 1, line 15 - page 4, second full paragraph do not make reference to either the first embodiment or the second embodiment and merely describe that the invention can preferably use attachment means with press-on/catch closure (see page 4, second full paragraph). In addition, the specification explains that "The present invention may include any novel features or combination of features disclosed herein..." (page 10, last paragraph). Thus, the specification describes that features of the different

embodiments can be combined. There is enablement for the invention as claimed in claim 16.

Claim 17

Claim 17 claims that the second housing is releasably attachable to the first housing by the attachment means which comprises a press-on/catch closure. Again, all the features of claim 17 are shown in Fig. 5 with regard to the second embodiment with the exception of the press-on/catch closure which is described in more detail with regard to the first embodiment shown in Figs. 1-4. However, as noted above, page 1, line 15 - page 4, second full paragraph do not make reference to either the first embodiment or the second embodiment and merely describe that the invention can preferably use attachment means with press-on/catch closure (see page 4, second full paragraph). In addition, the specification explains that "The present invention may include any novel features or combination of features disclosed herein..." (page 10, last paragraph). Thus, the specification describes that features of the different embodiments can be combined. There is enablement for the invention as claimed in claim 17.

B. 35 U.S.C. §103(a) (Kobayashi et al. (US 5,722,055) in view of Semenik et al. (US 5,233,506)) (Claims 1-9, 11, 12 and 15-17)

Claim 1

Claim 1 claims a first housing, a second housing and a cover. The cover is part of a retaining means for retaining electronic components (excluding the key unit) to the first

housing when the second housing is released from the first housing. The second housing is releasably attached to the first housing by a press-on/catch. Kobayashi et al. and Semenik et al. do not disclose or suggest the unique combination recited in claim 1 of a first housing, a second housing and a cover, wherein the cover is part of a retaining means for retaining electronic components (**excluding the key unit**) to the first housing when the second housing is released from the first housing, and the second housing is releasably attached to the first housing by a press-on/catch. The examiner stated that "43" in Kobayashi et al. is equivalent to applicants' claimed cover of applicants' claimed retaining means. This is incorrect. "43" in Kobayashi et al. is a shielding plate attached to a shield case 40. The shielding plate 43 in Kobayashi et al. does not form a retaining means for holding electronic components to the first housing 23.

Furthermore, Semenik et al. merely discloses a snap-lock connection of two housing pieces. This is not the same as applicants' claimed releasable attachment. In fact, column 7, lines 5-10 specifically address **preventing disengagement**. It appears that the examiner has been using applicants' patent application as a template for combining the references. This is improper. Semenik et al. does not disclose or suggest releasably attaching the two housing pieces to each other. There is no disclosure or suggestion in Semenik et al. of a user releasable attachment. Semenik et al. merely discloses snap-lock attaching the two housing pieces to each other. A snap-lock attachment is not necessarily a user releasable attachment. A person skilled in the art, looking at Kobayashi et al. and Semenik et al. would not have found applicants'

invention obvious because there is no disclosure or suggestion of the unique combination recited in claim 1 of a first housing, a second housing **user releasably attached to the first housing**, and a cover, wherein the cover is part of a retaining means for retaining electronic components (excluding the key unit) to the first housing when the second housing is released from the first housing, and the second housing is releasably attached to the first housing by a press-on/catch.

The examiner has stated that "...in telephone housing assembly, it is commonly seen that a press-on/catch is used to attach a first and a second housing together." It appears that the examiner is not relying on a "well known in the art" rejection, because the examiner did not respond with new art after applicant's attorney's request in accordance with MPEP §2144.03. It should be noted that a terminal disclaimer has been filed with regard to US 6,347,218. In addition, related U.S. Patent No. 7,092,520 B2 (a continuation-in-part patent application of the present patent application) has issued with claims similar to claim 1 of the present application.

Claims 2-5, 7-8, 11-13 stand or fall with claim 1.

Claim 6

Claims 6 claims that the cover is releasably engageable with the circuit so that a user may exchange covers easily without the use of a special tool. There is no disclosure or suggestion of this in the cited art. Therefore, claim 6 is patentable and should be allowed.

Claim 9

Claim 9 claims that a sealing member is retained by the cover. There is no disclosure or suggestion of this in the cited art. Therefore, claim 9 is patentable and should be allowed.

Claim 15

Claim 15 claims a back housing, a front housing and a retaining means comprising a cover. The retaining means holds electronic components to the back housing. The front housing is **releasably attachable** by a user to the back housing by a press-on/catch closure.

Shielding plate 43 in Kobayashi et al. is not a cover of a retaining means for retaining electronic components to the first housing 23. Shielding plate 43 is merely attached to shield case 40. Semenik et al. does not disclose or suggest releasably attaching the two housing pieces to each other. There is no disclosure or suggestion in Semenik et al. of a user releasable attachment. Semenik et al. merely discloses snap-lock attaching the two housing pieces to each other. A snap-lock attachment is not necessarily a user releasable attachment. A person skilled in the art, looking at Kobayashi et al. and Semenik et al. would not have found applicants' invention obvious because there is no disclosure or suggestion of the unique combination recited in claim 15.

Claim 16

Claim 16 claims a first housing, a second housing, and a retaining means comprising a cover for holding electronic components to the first housing. The second housing is **releasably attachable** by the user to the first housing by a press-on/catch closure.

Shielding plate 43 in Kobayashi et al. is not a cover of a retaining means for retaining electronic components to the first housing 23. Shielding plate 43 is merely attached to shield case 40. Semenik et al. does not disclose or suggest releasably attaching the two housing pieces to each other. There is no disclosure or suggestion in Semenik et al. of a user releasable attachment. Semenik et al. merely discloses snap-lock attaching the two housing pieces to each other. A snap-lock attachment is not necessarily a user releasable attachment. A person skilled in the art, looking at Kobayashi et al. and Semenik et al. would not have found applicants' invention obvious because there is no disclosure or suggestion of the unique combination recited in claim 16.

Claim 17

Claim 17 claims a first housing, a second housing and retaining means comprising a cover for holding electronic components to the first housing. Attachment means are provided for **releasably attaching** the second housing to the first housing by a user.

Shielding plate 43 in Kobayashi et al. is not a cover of a retaining means for retaining electronic components to the first housing 23. Shielding plate 43 is merely attached to shield case 40. Semenik et al. does not disclose or suggest releasably attaching the two housing pieces to each other. There is no disclosure or suggestion in Semenik et al. of a user releasable attachment. Semenik et al. merely discloses snap-lock attaching the two housing pieces to each other. A snap-lock attachment is not necessarily a user releasable attachment. A person skilled in the art, looking at Kobayashi

et al. and Semenik et al. would not have found applicants' invention obvious because there is no disclosure or suggestion of the unique combination recited in claim 17.

C. 35 U.S.C. §103(a) (Kobayashi et al. (US 5,722,055) in view of Semenik et al. (US 5,233,506) and Takagi (US 5,235,636)) (Claim 13)

Claim 13

Claim 13 stands or falls with claim 1.

VIII. Claims Appendix

Attached.

IX. Evidence Appendix

None.

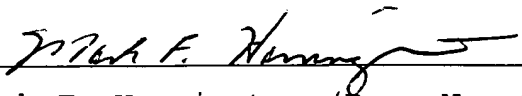
X. Related Proceedings Appendix

None.

Conclusion

In view of the arguments presented above, it is respectfully requested that the Examiner's rejections of Claims 1-9, 11-13 and 15-17 be reversed.

Respectfully submitted,


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12/15/06
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VIII. CLAIMS APPENDIX

The following is a list of the claims on appeal and, in accordance with USPTO procedures, does not include any objected to claims, cancelled claims, or allowed claims.

1. An electronic radiotelephone comprising:

a first housing;

a second housing user releasably attachable to the first housing to meet with the first housing around the periphery of the radiotelephone, wherein the second housing modifies the external appearance of the electronic radiotelephone to the personal tastes of the user; and

at least one key unit for user-actuation of at least one key sensor;

retaining means comprising a cover, for holding electronic components of the radiotelephone, including said key sensor but excluding said key unit, to the first housing when the second housing is released from attachment with the first housing by the user, wherein said key unit being free to move with respect to the first housing when the second housing is released from attachment with the first housing by the user; and

wherein said second housing is releasably attachable, by the user, to the first housing by a press-on/catch closure so that said second housing may be fitted on to the first housing by pressing it on.

2. An electronic radiotelephone as claimed in claim 1, wherein the second housing is a user interface housing of the radiotelephone.
3. An electronic radiotelephone as claimed in claim 1, wherein the retaining means comprises a circuit board of the radiotelephone.
4. An electronic radiotelephone as claimed in claim 3, wherein said at least one key sensor is provided on an outer surface of the circuit board.
5. An electronic radiotelephone as claimed in claim 3, wherein the cover is arranged to hold components of the radiotelephone between it and the said circuit board.
6. An electronic radiotelephone as claimed in claim 3, wherein the cover is releasably engageable with the circuit so that a user may exchange covers easily without the use of a special tool.
7. An electronic radiotelephone as claimed in claim 1, wherein at least one user interface component is retained by the cover.
8. An electronic radiotelephone as claimed in claim 7, wherein the cover includes an aperture overlying at least one user interface component retained by the cover.
9. An electronic radiotelephone as claimed in claim 1, wherein a sealing member is retained by the cover.
10. (cancelled)

11. An electronic radiotelephone as claimed in claim 1, wherein when the second housing is attached to the first housing, the key unit is sandwiched between the second housing and the key sensor.

12. An electronic radiotelephone as in claim 1, wherein the key unit is a key mat.

13. An electronic radiotelephone as claimed in claim 12, wherein the key sensor comprises a membrane switch.

14. (cancelled)

15. An electronic radiotelephone comprising:

a back housing providing at least one key sensor;

at least one key unit for user-actuation of at the least one key sensor by a user;

a front housing for modifying the external appearance of the electronic radiotelephone to the personal tastes of the user, the front housing having at least one opening for receiving said at least one key unit for user-actuation, and being user-releasable attachable to the back housing to meet with the back housing around the periphery of the radiotelephone, and retaining means comprising a cover, holding electronic components of the radiotelephone to the back housing when the front housing is released from attachment with the back housing by the user;

wherein when the front housing is attached to the back housing, the key unit is held between the front housing

and the at least one key sensor and the key unit is thereby received in the at least one opening of the front housing;

said key unit being user removable when the front housing is released from attachment with the back housing by the user, and;

wherein said front housing is releasably attachable by the user to the back housing by a press-on/catch closure so that said front housing may be fitted on to the back housing by pressing it on.

16. An electronic radiotelephone comprising:

a first housing;

a second housing for modifying the external appearance of the electronic radiotelephone to the personal tastes of an user, the second housing is releasable attachable, by an user, to the first housing to meet with the first housing around the periphery of the radiotelephone;

at least one key unit for user-actuation of at least one key sensor;

retaining means comprising a cover, for holding electronic components of the radiotelephone to the first housing when the second housing is attached to the first housing with the first housing, wherein when the second housing is attached to the first housing, the key unit is sandwiched between the second housing and the at least one key sensor, said key unit being free to move with

respect to the first housing when the second housing is released from attachment with the first housing by the user; and

wherein said second housing is releasably attachable, by the user, to the first housing by a press-on/catch closure so that said second housing may be fitted on to the first housing by pressing it on.

17. An electronic radiotelephone comprising:

a first housing;

a second housing for modifying the external appearance of the electronic radiotelephone to the personal tastes of an user, the second housing releasably attachable, by an user, to the first housing to meet with the first housing around the periphery of the radiotelephone;

attachment means for attaching the second housing to the first housing by a user without employing a tool, wherein said second housing is releasably attachable to the first housing by said attachment means which comprises a press-on/catch closure so that said second housing may be fitted on-to the first housing by pressing it on;

at least one key unit for user-actuation of at least one key sensor and retaining means comprising a cover, for holding electronic components of the radiotelephone, including said key sensor but excluding said key unit to the first housing when the second housing is released from attachment with the first housing, said key unit being free to move with respect to the first and second

housings when the second housing is released from attachment with the first housing by the user.

18-24. (Cancelled)

None

IX. EVIDENCE APPENDIX

X. RELATED PROCEEDINGS APPENDIX

None